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Calvin Mckerley

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PATENT APPLICATION

ATTORNEY DOCKET NO. 100202741-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert C. Aaron, et al

Confirmation No.:

Application No.: 10/716,257

Examiner: John Quoc Nguyen

Filing Date: Nov 18, 2003

Group Art Unit: 3654

Title: Apparatus and Method for Reversing Tapewind Direction

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on _____ herewith.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

1st Month
\$120

2nd Month
\$450

3rd Month
\$1020

4th Month
\$1590

The extension fee has already been filed in this application.

(b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Commissioner for Patents, Alexandria, VA 22313-1450
Date of Deposit:

Respectfully submitted,

Robert C. Aaron, et al

By:

Philip S. Lyren

Attorney/Agent for Applicant(s)

Reg No. : 40,709

Date : June 12, 2006

Telephone : 281 514 8236

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Date of facsimile: June 12, 2006

Typed Name: Carrie Mckerley

Signature: Carrie Mckerley

Rev 10/05 (ApBrief)

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Philip S. Lyren

Attorney/Agent for Applicant(s)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Robert C. Aaron, et al. Examiner: John Quoc Nguyen
Serial No.: 10/716,257 Group Art Unit: 3654
Filed: November 18, 2003 Docket No.: 100202741-1
Title: Apparatus and Method for Reversing Tapewind Direction

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is filed in response to the Final Office Action mailed March 14, 2006.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

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I. REAL PARTY IN INTEREST

The real party-in-interest is the assignee, Hewlett-Packard Company, a Delaware corporation, having its principal place of business in Palo Alto, California.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences known to appellant, the appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Appeal Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 – 4, 6 – 7, 9 – 12, and 14 are finally rejected. The rejection of these claims is appealed.

IV. STATUS OF AMENDMENTS

No amendments were made after receipt of the Final Office Action. All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R.

§ 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element or that these are the sole sources in the specification supporting the claim features.

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Claim 1

A reel (FIG. 1, #16) comprising:
a hub (FIG. 1, #30; [0012]);
a guide member (#38) is positionable with respect to the hub such that the hub and the guide member cooperate to form a surface for receiving the magnetic tape (FIG. 2, #14; [0015]); and
a securing mechanism (FIG. 1, #44) for releasably securing the position of the guide member with respect to the hub (FIGS. 1-3; [0013], [0016]).

Claim 2

The reel as recited in claim 1, comprising at least one flange portion (FIG. 3, #28) coupled to the hub, wherein the securing mechanism is coupled to the at least one flange portion ([0016]).

Claim 3

The reel as recited in claim 2, wherein the securing mechanism includes a resilient member (FIG. 3, #58) configured to bias an engagement portion (FIG. 3, #56) coupled to the resilient member into a corresponding receiving portion (FIG. 3, #42) located on the guide member ([0016]).

Claim 9

A reel (FIG. 1, #16) comprising:
a hub (FIG. 1, #30; [0012]);
a guide member (#38) positionable with respect to the hub such that the hub and the guide member cooperate to form a surface for winding the magnetic tape (FIG. 2, #14; [0015]); and
a securing mechanism (FIG. 1, #44) configured to secure the guide member to the hub, such that magnetic tape is windable onto the hub and the guide member in a first direction of rotation (FIG. 4, #62) and a second direction of rotation (FIG. 4, #70) while the guide member is secured to the hub (FIGS. 1-4; [0013], [0016], [0021]).

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Claim 11

The reel as recited in claim 9, wherein the securing mechanism comprises at least one resilient member (FIG. 3, #58) moveable to lock the position of the guide member with respect to the hub. ([0016])

Claim 12

The reel as recited in claim 11, wherein the securing mechanism comprises a flange (FIG. 3, #28) with a tab (FIG. 3, #56; [0016]).

Claim 14

The reel as recited in claim 9, wherein the first direction of rotation is a clockwise direction and the second direction of rotation is a counter-clockwise direction ([0021]).

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 – 4, 6 – 7, 9 – 12, and 14 are rejected under 35 USC § 102(b) as being anticipated by USPN 4,709,873 (Smith).

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VII. ARGUMENT

The rejection of claims 1 – 4, 6 – 7, 9 – 12, and 14 is improper, and Applicants respectfully requests reversal of these rejections.

The claims do not stand or fall together. Instead, Applicants present separate arguments for various independent and dependent claims. Each of these arguments is separately argued below and presented with separate headings and sub-heading as required by 37 C.F.R. § 41.37(c)(1)(vii).

Claim Rejections: 35 USC § 102(b)

Claims 1 – 4, 6 – 7, 9 – 12, and 14 are rejected under 35 USC § 102(b) as being anticipated by USPN 4,709,873 (Smith). These rejections are traversed.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Applicants will show that since Smith does not teach each element in the rejected claims, these claims are allowable over Smith.

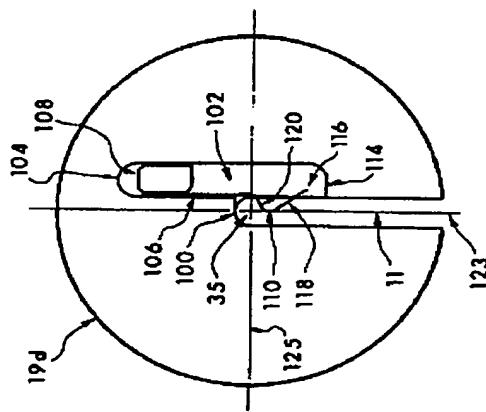
As a precursor to the arguments, Applicants provide an overview of Smith.

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Independent Claim 1

Claim 1 recites numerous limitations that are not taught in Smith. By way of example, claim 1 recites that the hub and the guide member “cooperate to form a surface for receiving the magnetic tape” (emphasis added). In other words, both the hub and the guide member form a surface. Nowhere does Smith teach or even suggest a hub and guide member that cooperate to form a surface for receiving magnetic tape.

In the Office Action, the Examiner associates element 16 (i.e., the threader pin) with the claimed guide member. Element 19A in Smith is a hub of the take-up reel 19 (4: 54-550). Element 16 in Smith, however, does not cooperate with the hub “to form a surface for receiving the magnetic tape.” Smith expressly teaches that “the main purpose of our device 19d is to receive and locate a threader pin 16 at the axis of rotation 35A of the take-up reel 19” (5: 15-17). The axis of rotation extends through the interior of the hub 19A, nowhere near the surface of the hub. As shown in FIGS. 1 and 2, threader pin 16 enters slot 11 and stops at point 100 so the threader pin is at the axis of rotation 35 (see 5: 43 – 48). For convenience, Applicants reproduce FIG. 2 of Smith below:



Again, since the threader pin 16 is located inside the hub 19A at location 35, the hub and threader pin cannot “cooperate to form a surface for receiving the magnetic tape.”

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For at least these reasons, Smith does not teach or even suggest all the elements of independent claim 1. The dependent claims that depend from independent claim 1 are allowable for at least these reasons.

Response to Office Action Arguments

The Final Office Action argues that Smith actually includes a leader block that “is not shown but is old and well known (see at least the patents to Rinkleib et al, Richard et al, and Crama, which are cited in Smith et al) a device for filling up the opening/slot 11 of the reel to form a substantially continuous winding surface for the tape” (see FOA at pages 2-3). Applicants respectfully disagree with this argument.

First, Smith does state that a “leader block and its associated tape are not shown” (4: 45-46). Smith, however, does not state how the leader block cooperates with the hub and threader pin. Even though Smith mentions that his take-up reel includes a leader block, this fact does not mean that his take-up reel with a leader block teaches the elements of Applicants’ claims. Claim 1 recites that the hub and guide member cooperate to form a surface for receiving the magnetic tape. By contrast, Smith shows a threader pin that enters a slot in the hub and moves to an axial position **inside** the hub. Does the leader block in Smith also enter the slot and stop inside the hub? Does the leader block in Smith cooperate to form a surface for receiving or winding tape? How does the leader block connect or cooperate with the hub, the threader pin, etc.? Smith is silent on these issues. The six references cited by the Examiner do not explain how the embodiments in Smith could somehow be altered to teach the elements of the claims.

Second, the Examiner has cited six patents (four are to Richards et al). Applicants have reviewed these six patents but cannot locate any teaching wherein the hub and the guide member “cooperate to **form a surface** for receiving the magnetic tape” as recited in claim 1 or “cooperate to **form a surface** for winding the magnetic tape” as recited in claim 9. Further, the Examiner has not cited any particular location in these six patents or any particular element in these patents that correspond to the deficiencies of Smith.

Third, Applicants respectfully argue that to anticipate a claim, a single reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he

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elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As noted above, Smith does not teach or even suggest each element as recited in the claims.

Independent Claim 9

Claim 9 recites numerous limitations that are not taught or suggested in Smith. Examples are provided below.

Example 1

Claim 9 recites that the hub and the guide member "cooperate to form a surface for winding the magnetic tape" (emphasis added). As noted above in connection with claim 1, Smith does not teach that the hub 19A and threader pin 16 "cooperate to form a surface for winding the magnetic tape." The six references cited by the Examiner also do not teach how Smith could somehow be modified to teach the elements of claim 9.

For at least these reasons, Smith does not teach all the elements of independent claim 9. The dependent claims that depend from independent claim 9 are allowable for at least these reasons.

Example 2

As another example, claim 9 recites a securing mechanism to secure the guide member to the hub "such that the magnetic tape is windable onto the hub and the guide member" (emphasis added). Nowhere does Smith teach or even suggest that the magnetic tape is windable onto both the hub and the guide member.

In the Office Action, the Examiner associates element 16 (i.e., the threader pin) with the claimed guide member. Smith, however, does not teach that the magnetic tape is windable onto the hub and threader pin. As shown in FIGS. 1 and 2 of Smith, the threader pin 16 enters slot 11 and stops at point 100 so the threader pin is at the axis of rotation 35 (see 5: 43 – 48). Again, since the threader pin 16 is located inside the hub 19A, the magnetic tape is not "windable onto" the hub and guide member.

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For at least these reasons, Smith does not teach or suggest all the elements of independent claim 9. The dependent claims that depend from independent claim 9 are allowable for at least these reasons.

Example 3

As yet another example, claim 9 recites that the magnetic tape is windable onto the hub and guide member in two different directions. Specifically, the magnetic tape is windable “in a first direction of rotation and a second direction of rotation while the guide member is secured to the hub.” Smith does not teach or suggest these recitations.

The Office Action has not even addressed these recitations. In other words, the Office Action has not cited a single location whatsoever in Smith for teaching these recitations. Applicants have carefully reviewed Smith but cannot locate any section whatsoever that teaches or even suggests that magnetic tape is windable in first and second directions of rotation while the guide member is secured to the hub.

For at least these reasons, Smith does not teach or suggest all the elements of independent claim 9. The dependent claims that depend from independent claim 9 are allowable for at least these reasons.

Dependent Claim 3

In addition to the reasons provided above with respect to independent claim 1, dependent claim 3 recites that the “securing mechanism includes a resilient member configured to bias an engagement portion coupled to the resilient member into a corresponding receiving portion located on the guide member.” Smith does not teach these elements.

In one embodiment shown in FIGS. 1 and 2, Smith teaches a spring 106 that retains the threader pin 16 in slot 11. As shown best in FIG. 2, Smith explains:

That is, as rod 17 enters slot 11, it will impinge upon the front surface 118 of leaf spring 106 and depress the entire raised part 110 into slot 102. Similarly, as rod 17 leaves slot 11 it will impinge

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upon the rear surface 120 of leaf spring 106 and again depress the entire raised part 110 into slot 102. (6: 10 – 15).

Nowhere does the spring 106 (i.e., corresponding to the claimed “resilient member”) bias an engagement portion “into a corresponding receiving portion on the guide member.” The threader pin 16 does not have a receiving portion. In fact, nothing is biased **into** the threader pin 16 in Smith. As explained above (see FIG. 2 and 6:10 – 15 of Smith), the threader pin 16 passes the spring 106 and gets trapped into slot 11.

In a second embodiment shown in FIG. 3, Smith teaches a biasing means as ball 106A and spring 106B. The biasing means performs “the same function as the raised leaf spring shown in FIGS. 1 and 2” (6: 32-34). In other words, the threader pin 16 passes the ball 106A and becomes trapped in the slot 11 (6: 51-63).

Nowhere does the biasing means (i.e., corresponding to the claimed “resilient member”) bias an engagement portion “into a corresponding receiving portion on the guide member.” The threader pin 16 does not have a receiving portion. In fact, nothing is biased **into** the threader pin 16 in Smith. As explained above (see FIG. 3 and 6: 51-63 of Smith), the threader pin 16 passes the ball 106A and gets trapped into slot 11.

For at least these additional reasons, dependent claim 3 is allowable over Smith.

Dependent Claim 12

In addition to the reasons provided above with respect to independent claim 9, dependent claim 12 recites that the “securing mechanism comprises a flange with a tab.” The Office Action argues that Smith shows the tab at element #110. Applicants respectfully disagree with the argument.

Claim 12 recites that the securing mechanism has two different elements: (1) a flange, and (2) a tab. The Office Action has not cited any portion in Smith that corresponds with both of these elements. Instead, the Office Action merely states: “The tab of claim 12 reads on at least element 110.”

In short, the Office Action has not identified any section or elements in Smith that correspond with all of the elements of claim 12. For at least these reasons, the Office

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Action has not established a prima facie case. Smith does not anticipate all of the elements of claim 12.

Further, Applicants argue that FIG. 2 shows a spring 106 and FIG. 3 shows a biasing means for trapping a threader pin 16 into slot 11. Nowhere does the securing mechanism of Smith include both a flange and tab as recited in claims 12, 11, and 9.

Dependent Claim 14

In addition to the reasons provided above with respect to independent claim 9, dependent claim 14 recites that “the first direction of rotation is a clock-wise direction and the second direction of rotation is a counter-clockwise direction.”

First, the Office Action has not addressed these recitations whatsoever. The Office Action has ignored the elements of this dependent claim. For at least these reasons dependent claim 14 is allowable over Smith.

Second, Applicants have carefully reviewed Smith and cannot locate any section that teaches or even suggests that the magnetic tape is windable onto the hub in two directions: a first direction of rotation is a clock-wise direction and a second direction of rotation is a counter-clockwise direction. For at least these reasons dependent claim 14 is allowable over Smith.

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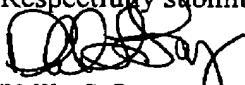
CONCLUSION

In view of the above, Applicants respectfully request the Board of Appeals to reverse the Examiner's rejection of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (832) 236-5529. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

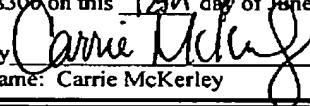
Respectfully submitted,



Philip S. Lyren
Reg. No. 40,709
Ph: 832-236-5529

CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 12th day of June, 2006.

By 
Name: Carrie McKerley

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VIII. Claims Appendix

1. (original) A reel comprising:

a hub;

a guide member is positionable with respect to the hub such that the hub and the guide member cooperate to form a surface for receiving the magnetic tape; and

a securing mechanism for releasably securing the position of the guide member with respect to the hub.

2. (original) The reel as recited in claim 1, comprising at least one flange portion coupled to the hub, wherein the securing mechanism is coupled to the at least one flange portion.

3. (original) The reel as recited in claim 2, wherein the securing mechanism includes a resilient member configured to bias an engagement portion coupled to the resilient member into a corresponding receiving portion located on the guide member.

4. (original) The reel as recited in claim 1, wherein the securing mechanism locks the guide member and the hub to a first position and unlocks the guide member and the hub to a second position.

5. (withdrawn) The reel as recited in claim 4, wherein the securing mechanism comprises engageable tab and notch structures correspondingly located on the hub and the guide member.

6. (original) The reel as recited in claim 1, the securing mechanism comprises a biasing member to secure the position of the guide member with respect to the hub.

7. (original) The reel as recited in claim 6, wherein the securing mechanism engages the guide member to a hub in a first position and disengages the guide member to the hub in a second position.

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8. (withdrawn) The reel as recited in claim 1, wherein at least one of the hub, guide member, and the securing mechanism comprises magnetic components.

9. (original) A reel comprising:

a hub;

a guide member positionable with respect to the hub such that the hub and the guide member cooperate to form a surface for winding the magnetic tape; and

a securing mechanism configured to secure the guide member to the hub, such that magnetic tape is windable onto the hub and the guide member in a first direction of rotation and a second direction of rotation while the guide member is secured to the hub.

10. (original) The reel as recited in claim 9, wherein the securing mechanism releasably engages the guide member to the hub.

11. (original) The reel as recited in claim 9, wherein the securing mechanism comprises at least one resilient member moveable to lock the position of the guide member with respect to the hub.

12. (original) The reel as recited in claim 11, wherein the securing mechanism comprises a flange with a tab.

13. (withdrawn) The reel as recited in claim 9, comprising a track portion located on the flange portion and configured to direct the guide member into engagement with the securing mechanism to form the surface in cooperation with the hub.

14. (original) The reel as recited in claim 9, wherein the first direction of rotation is a clock-wise direction and the second direction of rotation is a counter-clockwise direction.

15. - 27. (cancelled)

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IX. EVIDENCE APPENDIX

None.

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X. RELATED PROCEEDINGS APPENDIX

None.